

REMARKS

A. Status of the Claims

Pending in this application are claims 1-3. Of these claims, only claim 1 is independent. Claim 1 has been amended and new claims 4-15 have been added. Support for these amendments and new claims can be found throughout the specification. Applicant has amended the specification to correct a typographical error. Applicant submits that no new matter has been added.

B. Summary of the Non-Final Office Action Mailed July 16, 2009

In the Non-Final Office Action mailed July 16, 2009, the Examiner rejected claims 1-3 under 35 U.S.C. § 102(b) as being allegedly anticipated by Scholder et al., U.S. Patent No. 5,831,821 ("Scholder").

Applicant thanks the Examiner for the thorough examination, and Applicant responds to the rejection as follows.

C. Response to 35 U.S.C. § 102 Rejection

The Examiner rejected claims 1-3 under § 102(b) as being allegedly anticipated by Scholder. Applicant submits that this rejection was improper and should be withdrawn because Scholder does not disclose each and every element of anyone of claims 1-3, and the Examiner did not establish a *prima facie* case of anticipation.

i. Scholder does not disclose each and every element of claim 1

Claim 1 as amended recites, *inter alia*, "a back board including a front face and a rear face, wherein the front face is configured to connect to the front PCBs" and "wherein the rear face of the back board is configured to connect to the rear PCBs"

In rejecting claim 1, the Examiner asserted "Scholder et al. teach a shelf unit for use in a rack for communication equipment including back body side panels 58 having L-

shaped slots 58e and having front and rear ends defining a space capable of containing PCB's, a back body with side plates having connecting members 34b." (Office Action p. 2)

Applicant submits that Scholder does not disclose "a back board including a front face and a rear face, wherein the front face is configured to connect to the front PCBs" and "wherein the rear face of the back board is configured to connect to the rear PCBs" as recited in claim 1. Scholder discloses a different arrangement of expansion cards in the cage assembly. Scholder discloses all of the expansion cards mount to the *same* face of the cage assembly, and all of the expansion cards connect to the *same connector* "to complete the connections between the expansion cards 40a-40d and the motherboard 8." Scholder col. 3, lines 50-61; Scholder col. 4 line 64-col. 5 line 3. Thus, Scholder does not disclose "a back board including a front face and a rear face, wherein the front face is configured to connect to the front PCBs" and "wherein the rear face of the back board is configured to connect to the rear PCBs" as recited in claim 1.

Accordingly, Applicant submit that claim 1 is allowable over Scholder for at least the foregoing reasons. Applicant further submits that claims 2-6 are allowable for at least the reason that they depend from an allowable claim.

ii. The Examiner did not establish a *prima facie* case of anticipation

"The examiner bears the burden of presenting at least a *prima facie* case of anticipation." *In re Sun*, 31 U.S.P.Q. 2d (BNA) 1451, 1453 (Fed. Cir. 1993). The Examiner did not establish a *prima facie* case of anticipation because the Examiner did not assert Scholder discloses each and every element of any one of claims 1-3.

Claim 1 as amended recites, *Inter alia*, "a front body including a pair of side panels having front and rear ends and defining a space for containing front PCBs and connecting members mounted adjacent to the rear ends of the side panels and protruding outward from the side panels."

In rejecting claim 1, the Examiner asserted "Scholder et al. teach a shelf unit for use in a rack for communication equipment including back body side panels 58 having L-shaped slots 58e and having front and rear ends defining a space capable of containing PCB's, a back body with side plates having connecting members 34b." (Office Action p. 2) While the Examiner asserted that Scholder discloses some elements of one of the pending claims, the Examiner did not assert that Scholder discloses "a front body including a pair of side panels having front and rear ends and defining a space for containing front PCBs and connecting members mounted adjacent to the rear ends of the side panels and protruding outward from the side panels" as recited in claim 1. Because the Examiner did not describe which portions of Scholder correspond to each and every element of claim 1, the Examiner did not establish a *prima facie* case for anticipation.

Further, because claims 2-3 depend from claim 1 and thus include all of the elements of claim 1, the Examiner did not establish a *prima facie* case of anticipation for claims 2-3.

ii. Scholder does not anticipate new claims 4-15

Applicant has added new claims 4-14. Of these claims, claims 7 and 11 are independent. Scholder does not anticipate claims 7 and 11 because Scholder does not disclose each and every element of anyone of these claims.

For example, claim 7 recites, "a back board having a front face and a rear face, wherein when the back board is fixed to the rear end of the front body, the front face of the back board configured to connect to the first set of PCBs, the rear face of the back board configured to connect to the second set of PCBs"

As stated above, Scholder discloses all of the expansion cards mount to the *same* face of the cage assembly, and all of the expansion cards connect to the *same connector* "to complete the connections between the expansion cards 40a-40d and the motherboard 8." Scholder col. 3, lines 50-61; Scholder col. 4 line 64-col. 5 line 3. That is not equivalent

to disclosure of different sets of PCBs connecting to different faces. Thus, Scholder does not disclose the above-recited elements of claim 7.

As another example, claim 11 recites, "connecting the first PCB to the front face of the back board" and "connecting the second PCB to the rear face of the back board."

As stated above, Scholder discloses all of the expansion cards mount to the *same face* of the cage assembly, and all of the expansion cards connect to the *same connector* "to complete the connections between the expansion cards 40a-40d and the motherboard 8." Scholder col. 3, lines 50-61; Scholder col. 4 line 64-col. 5 line 3. That is not a disclosure of different PCBs connecting to different faces. Thus, Scholder does not disclose "connecting the first PCB to the front face of the back board" and "connecting the second PCB to the rear face of the back board" as recited in claim 11.

Accordingly, Applicant submits that claims 7 and 11 are allowable over Scholder for at least the foregoing reasons. Further, Applicant submits that claims 4-6, 8-10, and 12-14 are allowable for at least the reason that they depend from an allowable claim.

CONCLUSION

In light of the above amendments and remarks, Applicant submits that the present application is in condition for allowance and respectfully requests notice to this effect. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney, at 312-913-3305.

Respectfully submitted,

**McDonnell Boehnen
Hulbert & Berghoff LLP**

Dated: October 14, 2009

By: /Robert J. Irvine III/
Robert J. Irvine III
Reg. No. 41,865